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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,016	10/10/2000	David K. Kovalic	16517.031	9497

28381 7590 08/27/2003

ARNOLD & PORTER  
IP DOCKETING DEPARTMENT; RM 1126(b)  
555 12TH STREET, N.W.  
WASHINGTON, DC 20004-1206

EXAMINER

ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 08/27/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/684,016

Applicant(s)

KOVALIC ET AL.

Examiner

Shubo "Joe" Zhou

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

THE REPLY FILED 31 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): rejection of claim 15 under 35 USC 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 11-16.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Note the attached Interview Summary (Paper #17)

Continuation of 5. does NOT place the application in condition for allowance because:

In regard to the rejection of claims 1-16 under 35 USC 101 (rejection for lack of utility), applicants do not argue and do not request reconsideration. The amendment to claims 13-15 do not change the substance of the claimed subject matter. The rejection stands.

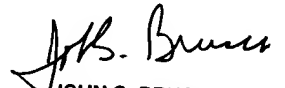
In regard to the rejection of claims 1-16 under 35 USC 112, first paragraph (enablement rejection due to lack of utility), applicants do not argue and do not request reconsideration. The amendments to claims 13-15 do not change the substance of the claimed subject matter. The rejection stands.

In regard to the rejection of claims 1-15 under 35 USC 112, first paragraph (written description rejection), applicants do not argue and do not request reconsideration. The amendments to claims 13-15 do not change the substance of the claimed subject matter. The rejection stands.

In regard to the rejection of claim 14 under 35 USC 112, first paragraph (new matter rejection), applicants argue that the limitation of "base pairs 1 through 123 of SEQ ID NO:48411" is described on page 14 lines 18-23, page 18, lines 26-28 of the specification. The examiner is unable to find the limitation in the asserted pages and lines of the specification. The amendment to claim 14 merely replaces "base pairs" to "nucleotides". However, the limitation of "nucleotides 1 through 123 of SEQ ID NO:48411" is still not adequately described in the specification. The rejection stands.

In regard to the rejection of claim 15 under 35 USC 112 second paragraph, the rejection is hereby withdrawn in view of the amendment to the claim.

In regard to the rejection of claim 13 under 35 USC 102(b), applicants do not argue and do not request reconsideration. The amendments to claim 13 do not change the substance of the claimed subject matter. The rejection stands.



JOHN S. BRUSCA, PH.D  
PRIMARY EXAMINER